

Remarks

In the final rejection of September 9, 2011, the Office maintained the written description rejection of the previous action which the Office, per page 2 of the Action, rewrote to address applicants' amendment.

However, the rewriting addressed exclusively the broadest claim. None of the dependent claims and new claims specifically added to address the Office concerns were discussed. Applicants respectfully submit that this practice is at odds with the Office's policy of compact prosecution. MPEP 2106 (II) states:

"It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement."

The Office is also referred to the following pertinent material:

"Applicants and Examiners both must be committed to compact prosecution in order to achieve the efficiency we all seek." (Director's Forum, June 28, 2010);

- Supplementary Examination Guidelines, 76 FR 7162, 7169 (Feb. 9, 2011) ("Practice Compact Prosecution"), which do discuss dependent claims in a way that assumes that they are in fact reviewed;

- August Patents Dashboard Overview (September 23, 2011), Guest blog by USPTO Commissioner for Patents Bob Stoll available <http://www.uspto.gov/blog/>

The Office confirms that claims 65, 67, 68, 70-72, 74-91, 103, 105-107, 111-115, 117-119 and 122-126 are currently under examination. However, the Office does not even mention in the rejection the melting temperatures referenced, among others, in claim 72 (between 55 to 75 °C) or 123 (between 55 to 62 °C) or the DNA bending values (more than 4 radial degrees) even though the Office seems to acknowledge that these types of limitation are relevant for the showing of "possession" of the invention by citing *Lockwood v. American Airlines Inc.*, 107 F.3d 1565 (Fed. Cir. 1997).

With regard to the broadest claim, the Office has not provided any analysis why claim 62 should be treated differently from claim 1 of the "Written Description Training Material" of March 2008 to which applicants referred in their response of June 23, 2011 (page 16).

Based on the above, applicants request that the Office withdraws the finality of the Office Action of September 9, 2011 or otherwise provides further input with regard to the dependent claims and the "Written Description Training Material". If at any point, the Examiner would like to conduct an Examiner initiated interview to further the prosecution of this case, the Examiner is invited to contact the undersigned at the number provided below.

The Commissioner is authorized to charge fee deficiencies and overpayment in connection with this filing to undersign's deposit account 50-3135.

Respectfully submitted,

/Joyce v. Natzmer/
By : Joyce von Natzmer
Registration No. 48,120
Customer No. 46002
Direct Telephone: (301) 657-1282

November 9, 2011

Pequignot + Myers LLC
200 Madison Ave., Suite 1901
New York, NY 10016